

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER H. THOMPSON

Appeal No. 1998-1795
Application No. 08/485,682

ON BRIEF

Before THOMAS, BARRETT and LALL, Administrative Patent Judges.
LALL, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the final rejection¹ of claims 1 to 10, which constitute all the claims in the case.

The invention is directed to a parking circuit for windshield wipers for a motor vehicle. The parking circuit senses when the wipers reach their parked, stowed position, and then terminates power to the wiper motor, thereby causing the wipers to remain stationary in their parked positions.

¹ There was an amendment after the final rejection as paper no. 11 whose entry was not approved by the Examiner [paper no. 12].

Appeal No. 1998-1795
Application No. 08/485,682

The invention provides both a parking function and an intermittent wiping function, but through the parking circuit alone, plus a few additional components. To attain the parking function, the invention actuates the parking circuit, while to attain the intermittent wiping, the invention periodically pulses the parking circuit. The invention is further illustrated by the following claim below.

1. In a windshield wiping system, which includes a parking system which (1) parks a wiper, and then (2) terminate power to a wiper motor, the improvement comprising:

a) means for repeatedly invoking the parking system, to cause intermittent wiping.

The Examiner relies on the following references:

Riester 1971	3,579,067	May 18,
Resch et al. (Resch) 1995	5,404,085	Apr. 4,

Claims 7 to 10 stand rejected under 35 U.S.C. § 112, second paragraph. Claims 1 to 7 and 10 stand rejected under 35 U.S.C.

§ 102 over Riester, while claims 8 and 9 stand rejected under 35 U.S.C. § 103 over Riester and Resch.

Appeal No. 1998-1795
Application No. 08/485,682

Rather than repeat in toto the positions and the arguments of Appellant or the Examiner, we make reference to the briefs² and the answer for their respective positions.

² A reply brief was filed as paper no. 14 which was entered in the record [paper no. 15].

Appeal No. 1998-1795
Application No. 08/485,682

OPINION

We have considered the rejections advanced by the Examiner. We have, likewise, reviewed Appellant's arguments against the rejections as set forth in the briefs.

We affirm-in-part.

Since there are rejections under 35 U.S.C. § 112, second paragraph, 35 U.S.C. § 102 and 35 U.S.C. § 103, we review the applicable laws before considering the specific rejections.

Rejection under 35 U.S.C. § 112, second paragraph

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C.

Appeal No. 1998-1795
Application No. 08/485,682

§ 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

Thus, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. As stated above, if the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. See Ex parte Porter, 25 USPQ2d 1144, 1146 (Bd. Pat. App. & Int. 1992).

Furthermore, appellants may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in In re Swinehart, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of

Appeal No. 1998-1795

Application No. 08/485,682

the type of language used to define the subject matter for
which patent protection is sought.

Appeal No. 1998-1795
Application No. 08/485,682

Rejection under 35 U.S.C. § 102

We note that a prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)). Rejection under 35 U.S.C. § 103

In rejecting a claim under 35 U.S.C. § 103, an examiner is under a burden to make out a prima facie case of obviousness. If that burden is met, the burden of going forward then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

We are further guided by the precedents of our reviewing court, under that while considering any rejection on 35 U.S.C.

Appeal No. 1998-1795
Application No. 08/485,682

§ 112, second paragraph, 102 or 103, limitations from the disclosure are not to be imported into the claims. In re Lundberg, 244 F.2d 543, 113 USPQ 530 (CCPA 1957); In re Queener, 796 F.2d 461, 230 USPQ 438 (Fed. Cir. 1986). We also note that the arguments not made separately for any individual claim or claims are considered waived. See 37 CFR § 1.192 (a) and (c). In re Baxter Travenol Labs., 952 F.2d 388, 391, 21 USPQ 2d 1281, 1285 (Fed. Cir. 1991) ("It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for nonobvious distinctions over the prior art."); In re Wiechert, 370 F.2d 927, 936, 152 USPQ 247, 254 (CCPA 1967) ("This court has uniformly followed the sound rule that an issue raised below which is not argued in this court, even if it has been properly brought here by reason of appeal is regarded as abandoned and will not be considered. It is our function as a court to decide disputed issues, not to create them.")

Analysis

At the outset, we note that usually the parking function of a windshield wiper is not thought of as the actuating force to achieve an intermittent running function. It is just the opposite, i.e., a parking function is a part of an

Appeal No. 1998-1795
Application No. 08/485,682

intermittent or a continuously running function. Thus, in our interpretation of the applied prior art, we approach it from the latter view point. This will further become clear as we discuss the various rejections below.

Claims 7 to 10 under 35 U.S.C. § 112, second paragraph

After our review of the Examiner's position [answer, pages 3, 4, 7 and 8] and Appellant's arguments³ [brief, pages 22 to 27 and reply brief, pages 1 to 5], we are of the opinion that the Examiner is being over-zealous in the application of 35 U.S.C.

§ 112, second paragraph. For example, whereas the fact that "the motor" (claim 7) lacks proper antecedent basis is correct, the scope of the claim is clear and its bounds definite, since there is only one motor involved in the claim and, furthermore, the very existence of a windshield wiper system requires a motor to be included in the system. As we pointed out above, the primary concern an Examiner should have in applying section 112, second paragraph to the claims is

³ Even though the amendment after the final rejection [paper no. 11] has not been approved for entry by the Examiner, its entry may enhance the clarity of the pertinent claims. However, we will leave that for the Examiner's discretion.

Appeal No. 1998-1795
Application No. 08/485,682

whether, in the context of the whole claim-recitation, the metes and bounds of the claim are clear and definite. Here, we conclude that they are. Similar remarks apply to the other shortcomings the Examiner has alleged regarding claims 7 to 10. The explanation and comments made by Appellant in the brief and the reply brief are self-explanatory and are further elaborated in the specification as pointed out therein by Appellant. (We note in passing that at places, Appellant's page references to the specification are incorrect; see, for example, that the reference to the "specification, page 9...", [reply brief, page 4] is misplaced, it should instead be pages 7 and 8.) Otherwise, we agree with the Appellant's position. Therefore, we do not sustain the rejection of claims 7 to 10 under 35 U.S.C. § 112, second paragraph.

Claims 1 to 7 and 10 under 35 U.S.C. § 102 over Riester

We first consider claim 1. We are persuaded by Appellant's argument [reply brief, pages 5 to 8] that element 54 of Riester is actuated by the rotation of the shaft of the motor 14, and not by the timing circuit 110 as alleged by the Examiner [answer, page 5]. However, if we consider the wiper system of Riester in the intermittent mode, fig. 2, we find that Riester is in a parking state when element 56 makes

Appeal No. 1998-1795
Application No. 08/485,682

contact with terminal 58, and in this state the driving power to the motor is terminated. Next, when the capacitor 92 gets charged to a critical voltage, a time period determined by the timing circuit 110, and contact 56 touches terminal 60, the power is applied to the motor for the duration of the dwell period, until the capacitor is discharged and the contact 56 touches terminal 58 [col. 3, line 34 to col. 4, line 42]; and the cycle repeats as long as the wiper system is in the intermittent mode. Therefore, we sustain the anticipation rejection of claim 1 by Riester.

With respect to claim 2, we further find that, in the intermittent mode, the wipers are in the park mode when the contact 56 is in contact with terminal 58 and capacitor 92 is charging but has not reached the critical voltage. As stated above, when the critical voltage is reached at capacitor 92 and contact 56 is at terminal 60, the wipers are withdrawn from the parking state. The cycle repeats as discussed above. Therefore, we sustain the anticipation rejection of claim 2 by Riester.

Regarding claim 3, we agree with Appellant that Riester does not disclose the limitation "containing no more than one relay." Riester does discuss that known intermittent dwell

Appeal No. 1998-1795
Application No. 08/485,682

wiper systems utilize relays (col. 1, lines 10 to 14), however, Riester does not anticipate the claimed limitation. Therefore, we do not sustain the anticipation rejection of claim 3 by Riester.

Regarding claims 4 and 5 (note that claim 5 has not been argued separately), we find that, in the intermittent mode, when contact 56 reaches terminal 58, and capacitor 92 has been fully discharged, the wiper is in the parked state. The wiper will stay parked until contact is moved by the rotating motor shaft to touch terminal 60. The rate of rotation of the motor shaft is indirectly determined by the timing circuit 110 since power to the motor is provided only when the capacitor 92 is charged to the critical voltage as discussed above. Thus, after a delay determined in part by the timing circuit 110, the wiper is driven out of the parking state. Therefore, we sustain the anticipation rejection of claims 4 and 5 by Riester.

With respect to claim 6, we sustain its anticipation rejection for the same rational as claims 1 and 4 above.

Regarding claim 7, we do not find, and neither has the Examiner found, the claimed "RUN signal" and the "RESUME signal" generated by Riester and their interaction with the

Appeal No. 1998-1795
Application No. 08/485,682

power delivery system to the motor. Therefore, we do not sustain the anticipation rejection of claim 7 by Riester.

With respect to claim 10, we do not sustain its anticipation rejection for the same rationale as claim 3 above.

Claims 8 and 9 under 35 U.S.C. § 103 over Riester and Resch

Regarding claim 8, we find, as above, that Riester in the intermittent mode (fig. 2) includes a parking system in which the power is made available in the operating region (contact 56 touching terminal 60 and capacitor 92 charged to the critical voltage), and the power is terminated when contact 56 is touching terminal 58 and capacitor 92 is discharged. Furthermore, we find the windshield wiper system of Riester runs the motor 14 from power coming from capacitor 92 in the intermittent parking mode, and in the continuous mode (fig. 4), the power to run motor 14 comes from terminal 102 (a source other than capacitor 92 which supplies power in the parking mode). Thus, Riester alone meets the recited limitations of claim 8, and the use of Resch in this rejection is merely cumulative. Therefore, we sustain the obviousness rejection of claim 8 over Riester and Resch.

Appeal No. 1998-1795
Application No. 08/485,682

Regarding claim 9, we do not find the claimed relay K1 in Riester. The addition of Resch does not cure this deficiency. Therefore, we do not sustain the obviousness rejection of claim 9 over Riester and Resch.

In summary, we have sustained the anticipation rejection of claims 1, 2, and 4 to 6 by Riester, while we have not sustained the anticipation rejection of claims 3, 7 and 10 by Riester. We have sustained the obviousness rejection of claim 8 over Riester and Resch, while we have not sustained the obviousness rejection of claim 9 over Riester and Resch. Finally, we also have not sustained the rejection of claims 7 to 10 under 35 U.S.C. § 112, second paragraph.

Appeal No. 1998-1795
Application No. 08/485,682

Accordingly, the decision of the Examiner rejecting
claims 1 to 10 is affirmed-in-part.

No period for taking any subsequent action in connection
with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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Appeal No. 1998-1795
Application No. 08/485,682

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